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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,165	06/12/2000	PATRICK W. GRAY	27866/34810	7556

7590

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EXAMINER

LI, BAO Q

ART UNIT

PAPER NUMBER

1648

DATE MAILED: 08/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/509,165

Applicant(s)

GRAY ET AL.

Examiner

Bao Qun Li

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/03/2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 26-43 is/are pending in the application.
- 4a) Of the above claim(s) 1-14, 27-29, 32-37 and 40-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26, 30, 31, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Information Disclosure Statement

The missing part of IDS originally filed on May 06, 2002 has been received by Office on June 03, 2003 and considered by the examiner.

Election/Restrictions

Applicants argue that the entire restriction should be removed because Vicari's murine "TECK" protein was a murine "counterpart" to human MDC of the present application and present Application discloses a murine MDC, which has a sequence unlike that of the murine chemokine disclosed by Vicari et al.

Applicants' argument has been respectfully considered; however, it is not found persuasive because the claimed invention of group I read not only on a specific sequence of MDC but also broadly on any or all non-human vertebrate MDA polypeptide and fragment thereof. Therefore, Vicari's disclosure read on it. Therefore, the lack of unity made by the previous Office Action is still proper and maintained.

Response to Amendment

This is a response to the amendment, paper No. 18, filed 06/03/03. Claims 26 and 30 have been amended. New claims 38-43 have been added. Claims 1-14 and 26-43 are pending. Claims 26, 30, 31 and 38-39 are considered before the examiner. However, Claims 40, 42 and 43 are not considered because they are not read on the elected groups.

Applicants are reminded that the newly submitted claims 40-43 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: they are not read on the elected group of invention and they are restricted in the Office Action, paper No. 14, mailed on May 06, 2002.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 40-43 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

This application contains claims 1-14, 27-29, 32-37 and 40-43 drawn to an invention nonelected with traverse in Paper No. 16. A complete reply to the final rejection must include

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cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Please note any ground of rejection(s) that has not been repeated is removed. Text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 26 and 30 are still rejected under 35 U.S.C. 112, first paragraph on the same ground as stated in the previous Office Action, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

3. Applicants argue that data published subsequent to the filing of the present application demonstrate that the invention described in the specification as filed can be practiced successfully. For example, Gonzalo et al. (Appendix C) and Lloyd et al. (Appendix D) demonstrate that an anti-MDC antibody to suppress OVA-induced allergy in a mouse model. Kawasski et al. (Appendix E) disclose an experiment, in which anti-TARC antibodies are used to cause a dramatic decrease in number of eosinophiles, lymphocytes infiltrated in the lavage fluid. Therefore, the rejection should be withdrawn.

4. Applicants' argument has been respectfully considered; however, it is not found persuasive because none of the published data (Appendixes C-E) as well as the specification provided by the Applicants support that the other polypeptide beside the antibodies against MDC is able are able to suppress an allergic reaction. However, the rejected claims are not only read on a method of using anti-MDC antibodies, but any or all MDC antagonist. Applicants are suggested to amend the claims to limited on anti-MDC antibodies to overcome the rejection.

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Allowable Subject Matter

Claims 38-39 are free rejection. However, they are not in the condition for allowance because they depend on the rejected claim 26.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Qun Li whose telephone number is 703-305-1695. The examiner can normally be reached on 7:00 to 4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 703-308-4027. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Bao Qun LI

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August 18, 2003


JAMES HOUSEL 82563
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600